

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9 Response  
JAS  
2/5/01

Applicant: Ronald Carr

Group Art Unit: 3626

Serial No.: 08/952,001

Examiner: Alison Pickard

Filed: November 7, 1997

Docket No.: P 97 194.024

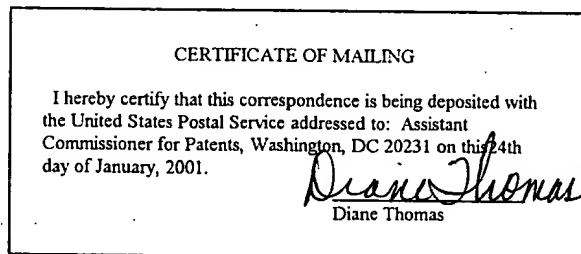
Title: JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET

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TO 3600 MAIL ROOM

RESPONSE



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Portland, OR 07204

January 24, 2001

Assistant Commissioner for Patents  
Washington, DC 20231

Greetings:

This is in response to the Office action mailed October 24, 2000 in the above-identified patent application. Applicant acknowledges the allowance of claims 56 - 58 and 88 - 92, and acknowledges the allowability of claims 59, 63 - 65, 70 - 72, 79 - 81, and 86 if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rejection of Claim 55

Claim 55 stands rejected as being anticipated by Merwarth, U.S. Patent No. 605,891 ("Merwarth"). The Examiner points out that Merwarth discloses forming its loops or eyes  $c^2$  of a soft metal, and forming its rings  $c$ ,  $c^3$  of a soft metal. Applicant respectfully traverses the rejection.

"A claim is anticipated only if . . . every element as set forth in the claim is found, either expressly or inherently described, in . . . the prior art reference." MPEP 2131.

Without conceding that a material can be considered to be “adapted for sealing” with reference only to its composition<sup>1</sup>, Merwarth states only that “[i]t may be desirable . . . in some cases, to form the loops or eyes c<sup>2</sup> of a soft-metal rod or wire of the *same size* as the soft-metal rings c and c<sup>3</sup> . . . .” (emphasis added). There are many different kinds of “soft metal.” Merwarth does not expressly state or inherently describe that the “soft metal” for the loops or eyes c<sup>2</sup> is the same soft metal used for the rings c<sup>3</sup>. Therefore, under MPEP 2131, there is no anticipation.

Rejections of Claims 60 - 62, 66 - 69, 73 - 78, and 82 - 84

Claims 60 - 62, 66 - 69, 73 - 78, and 82 - 84 stand rejected under 35 USC §103 as being unpatentable over Mastin, U.S. Patent No. 1,245,002 (“Mastin”) and Smith, U.S. Patent No. 4,002,344 (“Smith”). The Examiner has proposed a rationale for making the claimed combination under MPEP 2144, i.e., “to provide a gasket which can be properly aligned between a variety of different sized flanges [and] which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.” Applicant respectfully traverses the rejections.

The rejected claims all require the various elements of the gasket to be formed of the same “said sealing material.” The proposed rationale does not explain why the person of ordinary skill<sup>2</sup> would be motivated to form the locator of Smith of the same sealing material as the ribs or ridges of Mastin. The locator of Smith is not used to form a seal, so there was no known reason to form it of sealing material at all.

In fact, Mastin suggests that its packing is formed of rubber (Col. 1, line 10), while Smith teaches that its locator should be made of a thin plastic material such as polyethylene. Therefore, a straight-forward combination of the teachings of these references<sup>3</sup> would be to attach the snap-fitted polyethylene plastic locator of Smith to the rubber packing of Mastin, which clearly falls short of yielding the claimed invention.

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<sup>1</sup> It is possible that a sealing material could be adapted for sealing because of its form or configuration, and that it may not be enough for two materials to be considered the same sealing material for the two materials to have the same composition.

<sup>2</sup> Assuming, *arguendo*, that such a person would be motivated to combine Smith and Mastin in the first place.

<sup>3</sup> Id.

Rejection of Claims 85 and 87

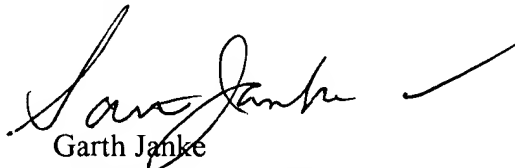
Claim 85 stands rejected under 35 USC §103 as being unpatentable over Mastin. The Examiner states that using a square outer periphery is merely a design choice, that applicant has not stated that the square outer periphery solves any problem, and that a circular shape would perform equally.

Applicant presumes that the rejection is intended to flow from MPEP 2144.04, which states that features relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art, citing *In re Seid*, 161 F2d 229, 73 USPQ 431 (CCPA 1947)<sup>4</sup>. However, it is not true that the square outer periphery relates merely to ornamentation or that a circular shape would perform equally well. As the Examiner as well as the person of ordinary skill in the art will readily appreciate, a square outer periphery has corners that would be accessible for assisting in aligning the gasket in a pipe joint that employs circular pipe flanges. This is a mechanical function and not mere ornamentation. Therefore, MPEP 2144.04 is inapplicable as a ground of rejection.

Claim 87 stands rejected under 35 USC §103 as being unpatentable over Mastin and further in view of Smith. Applicant respectfully traverses the rejection on all of the grounds stated above.

Accordingly, it is respectfully submitted that the claims pending in the application are all in condition for allowance, and the Examiner is respectfully requested to allow all of the claims, and pass this case to issue.

Respectfully submitted,

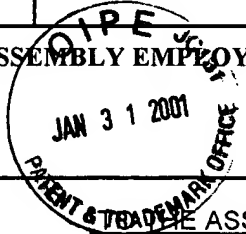
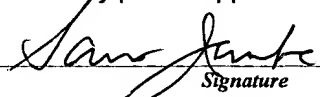
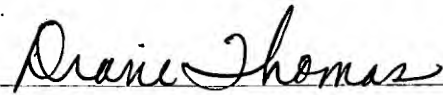


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<sup>4</sup> If Applicant's presumption is incorrect, the Examiner is respectfully requested to identify the authority for the rejection.

3626

<b>AMENDMENT TRANSMITTAL LETTER (Small Entity)</b>				Docket No. P 97 194.024	
Applicant(s): <b>Ronald Carr</b>					
Serial No. 08/952,001	Filing Date November 7, 1997	Examiner Alison Pickard	Group Art Unit 3626		
Invention: <b>JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET</b>				<b>RECEIVED</b>  <b>FEB 02 2001</b>  <b>TO 3600 MAIL ROOM</b>	
					
<u>THE ASSISTANT COMMISSIONER FOR PATENTS:</u>					
Transmitted herewith is an amendment in the above-identified application. <input checked="" type="checkbox"/> Small Entity status of this application has been established under 37 CFR 1.27 by a verified statement previously submitted. <input type="checkbox"/> A verified statement to establish Small Entity status under 37 FR 1.27 is enclosed. The fee has been calculated and is transmitted as shown below.					
<b>CLAIMS AS AMENDED</b>					
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	41 -	41 =	0 x	\$9.00	\$0.00
INDEP. CLAIMS	8 -	8 =	0 x	\$40.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
<b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT</b>					<b>\$0.00</b>
<input checked="" type="checkbox"/> No additional fee is required for amendment. <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ A duplicate copy of this sheet is enclosed. <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. <b>02-2451</b> A duplicate copy of this sheet is enclosed. <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. <input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17.					
 Signature			Dated: <b>January 24, 2001</b>		
<b>Garth Janke, Reg. No. 40,662</b> <b>BIRDWELL, JANKE &amp; DURANDO, PLC</b> <b>900 SW Fifth Avenue, Suite 1925</b> <b>Portland, Oregon 97204</b> <b>(503) 228-1841</b>					
CC:			I certify that this document and fee is being deposited on <b>January 24, 2001</b> with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.  Signature of Person Mailing Correspondence <b>Diane Thomas</b> Typed or Printed Name of Person Mailing Correspondence		

**CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)**Applicant(s): **Ronald Carr**

Docket No.

**P 97 194.024**

Serial No.

**08/952.001**

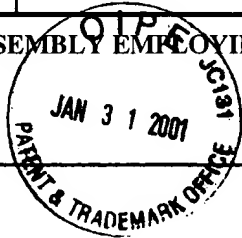
Filing Date

**November 7, 1997**

Examiner

**Alison Pickard**

Group Art Unit

**3626**Invention: **JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET****RECEIVED****FEB 02 2001****TO 3600 MAIL ROOM**I hereby certify that this amendment*(Identify type of correspondence)*

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The

Assistant Commissioner for Patents, Washington, D.C. 20231 on

January 24, 2001*(Date)***Diane Thomas***(Typed or Printed Name of Person Mailing Correspondence)*A handwritten signature in cursive script that reads "Diane Thomas".  
*(Signature of Person Mailing Correspondence)***Note: Each paper must have its own certificate of mailing.**